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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/579,285	05/30/2000	Nicholas S. Adams	6745	8319

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DORSEY & WHITNEY LLP  
50 SOUTH SIXTH STREET  
MINNEAPOLIS, MN 55402-1498

EXAMINER

ARK, DARREN W

ART UNIT	PAPER NUMBER
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3643

DATE MAILED: 03/06/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/579,285

Applicant(s)

ADAMS ET AL.

Examiner

Darren W. Ark

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6, 8, 9, 12-21 and 24-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6, 8, 9, 12-21 and 24-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 26-29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In reference to claim 26, the term "said weighted section" lacks antecedent basis.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-4, 6, 13-16, 24-27, 29 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Wohead 3,670,447.

Wohead discloses an elongated body (generally 13 of 12,10) with a line connection end (17, 29) and a free end (15,18) and having a buoyant section (20) and a weighted section (15), the weighted section made of a sinking material (15 is not buoyant; see col. 2, lines 16 & 17 wherein it states "...chamber 20 which is a buoyant portion of the device 10") and a noise generating element connected with the weighted section (15) at the free end (18, 15) so that the weighted section is between the buoyant

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section and the noise generating element, the noise generating element comprising a hollow member (14) and one or more noise generating objects (28).

In reference to claim 3, Wohead discloses the tubular member includes part (23) which is made of metal.

In reference to claim 13, Wohead discloses first and second weighted sections (17, 15).

In reference to claims 24 and 27, Wohead discloses the hollow member being a closed member (22 closes off one end while 25 closes off the other end).

In reference to claim 26, Wohead discloses an elongated body (generally 13 of 12, 10) having a line connection end (17, 29) and a free end (15, 18), the body made of at least in part of a solid weighted material having a density greater than water (15 is not buoyant), a weighted section (15), and a noise generating element (14, 23, 28) connected with the elongated body at the free end so that the entirety of the weighted portion (15) is between the noise generating element and the line connection end, the noise generating element comprising a hollow member (14) and one or more noise generating objects (28).

5. Claims 1, 6, 13-15, 24, 26, 27 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Witkoski 3,736,690.

In reference to claim 1, Witkowski discloses a body (16) with a line connection end (30), a free end (adjacent 40), a weighted section made of sinking material (32 made of metal [cross-section in Fig. 1]), a buoyant section (18), a noise generating element connected with the weighted section (40, 42, 44) at the free end so that the

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weighted section is between the buoyant section (18) and the noise generating element which comprises a hollow tube (50) and one or more noise generating objects (14).

In reference to claim 13, Witkowski discloses first and second weighted sections (36, 32).

In reference to claim 24, Witkowski discloses a closed hollow member (50 closed by 60, 32).

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 8, 23, 25, 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wohead 3,670,447.

Wohead discloses the claimed invention except for the noise generating element molded into the weighted portion. It would have been obvious to one having ordinary skill in the art at the time the invention was made to mold the noise generating element into the weighted portion, since it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art, and because molding the noise generating element with the weighted portion would assure that the noise generating element does not become easily separated therefrom and render the device useless. *Howard v. Detroit Stove Works*, 150 U.S. 164 (1893).

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In reference to claims 25 and 29, Alternatively Wohead does not disclose the hollow member made of a different material than the weighted material. It would have been an obvious matter of design choice to construct the hollow member out of different material than the weighted material, since applicant has not disclosed that by doing so solves any stated problem or is for any particular purpose and it appears that the hollow member and weighted material would perform equally as well by being made of different materials and because by making some portions that do not undergo stress out of cheaper materials would save costs in the design.

8. Claims 9, 20, 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wohead 3,670,447 in view of Tharp et al. 4,649,662.

Wohead does not disclose an exterior coating covering the body and noise generating element. Tharp et al. discloses a fishing post which may be made of different colors including fluorescent colors such as fluorescent reds and that they may also be made phosphorescent with special coatings and that wooden posts may be painted (coating of paint). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to employ the coating of Tharp et al. on the sinker of Wohead in order to make the sinker a certain color which will draw the attention of the fish to the sinker and therefore to the baited hook so as to catch more fish.

In reference to claim 9, Wohead and Tharp et al. do not particularly disclose a plastic seal coating. It would have been obvious to one having ordinary skill in the art at the time the invention was made to employ a plastic seal coating, since it has been held

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to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice, and because a plastic coating would be equally capable of providing the sinker with a certain color. *In re Leshin*, 125 USPQ 416.

9. Claims 12, 17-19, 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wohead 3,670,447 in view of Lysikowski 2,589,715, Dickinson 4,428,144, Rossa 4,750,289, or Rhinehart 5,253,447.

Wohead does not disclose a wire extending substantially through the entirety of the body wherein the wire has an end defining a line connection end. Lysikowski, Dickinson, Rossa, and Rhinehart all disclose a wire extending from a first end for line attachment and also through the body of the sinker and exiting and extending from the free end of the sinker for engagement with the bottom to prevent snagging in either the hook or the sinker. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the sinker of Wohead to include the wire member as taught by Lysikowski, Dickinson, Rossa, or Rhinehart to prevent the fishing rig from snagging on bottom obstructions.

In reference to claims 19 and 21, Wohead discloses the claimed invention except for the noise generating element molded into the weighted portion or the first and second weighted portions molded to opposite ends of the buoyant portion. It would have been obvious to one having ordinary skill in the art at the time the invention was made to mold the noise generating element into the weighted portion and to mold the first and second weighted portions to the opposite ends of the buoyant portion, since it

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has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art, and because molding the noise generating element with the weighted portion and the first and second weighted portions to the opposite ends of the buoyant portion would both assure that the noise generating element does not become easily separated therefrom and render the device useless and assure that the buoyant portion does not take on water to make it non-buoyant. *Howard v. Detroit Stove Works*, 150 U.S. 164 (1893).

10. Claims 20, 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Witkoski 3,736,690 in view of Tharp et al. 4,649,662.

Witkowski does not disclose an exterior coating covering the body and noise generating element. Tharp et al. discloses a fishing post which may be made of different colors including fluorescent colors such as fluorescent reds and that they may also be made phosphorescent with special coatings and that wooden posts may be painted (coating of paint). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to employ the coating of Tharp et al. on the sinker of Witkowski in order to make the device a certain color which will draw the attention of the fish to the device and therefore to the baited hook so as to catch more fish.

11. Claims 25, 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Witkoski 3,736,690.

Witkowski does not disclose the hollow member made of different material than the weighted material. It would have been an obvious matter of design choice to



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construct the hollow member out of different material than the weighted material, since applicant has not disclosed that by doing so solves any stated problem or is for any particular purpose and it appears that the hollow member and weighted material would perform equally as well by being made of different materials and because by making some portions that do not undergo stress out of cheaper materials would save costs in the design.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Darren W. Ark whose telephone number is (703) 305-3733. The examiner can normally be reached on M, T, Th, & F, 8:00am-6:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter M. Poon can be reached on (703) 308-2574. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 306-4195 for regular communications and (703) 306-4195 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.



Darren W. Ark  
Primary Examiner  
Art Unit 3643

DWA *DWA*  
March 2, 2002